UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/478,714	01/06/2000	TONY S. EL-KIK	BAYS-10-8-2	2054

8933 7590 02/26/2003

DUANE MORRIS, LLP
ATTN: WILLIAM H. MURRAY
ONE LIBERTY PLACE
1650 MARKET STREET
PHILADELPHIA, PA 19103-7396

EXAMINER	
HUISMAN, DAVID J	
ART UNIT	PAPER NUMBER
2183	

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/478,714	Applicant(s) EL-KIK ET AL.	
	Examiner David J. Huisman	Art Unit 2183	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☐ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See attached sheet*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8.☒ The proposed drawing correction filed on *13 February 2003* is a)☐ approved or b)☒ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

Regarding the amended Fig.1, the added RDN signal is approved but this addition requires additional amendments within the specification. For example, on page 5, lines 18, the RDN signal is said to be "(not shown)". This occurrence (along with all other existing occurrences) should be replaced with a reference number and the reference number should be also shown in Fig.1.

Furthermore, the applicant has argued on page 3 of the request for reconsideration:

"In response to the Applicant's arguments, the Examiner has proffered extensive explanations for why each of the above assertions is true, but has failed to point to 'some teaching, suggestion or motivation in the prior art to make the specific changes made by the applicant' as required by the case law interpreting 35 U.S.C. 103."

This argument is not found persuasive because of the following reasons:

"In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference." In re Oetiker, 24 USPQ2d 1443 (CAFC 1992).

Accordingly, Evoy et al. (U.S. Patent No. 6,085,307) and McCarthy (U.S. Patent No. 6,321,310) are not required to disclose or specifically suggest particular elements. Instead, the measure is what the teachings of Evoy and McCarthy would suggest to one of ordinary skill in the art, not what Evoy and McCarthy specifically suggest.

For Applicant's benefit, portions of In re Oetiker, 24 USPQ2d 1443 (CAFC 1992), which correspond to the test of obviousness, have been attached hereafter...

"whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention,"
In re Gorman, 933 F.2d at 986, 18 USPQ2d at 1888.

Subject matter is unpatentable under section 103 if it "'would have been obvious . . . to a person having ordinary skill in the art.' While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination."
In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988).

"Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it addresses."
In re Wood, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979).

"In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference."

Entire quote from In re Oetiker, 24 USPQ2d 1443 (CAFC 1992).

EDDIE CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100